

Appl. No. 10/720,531  
Docket No. T-716A (Z-03830R)  
Amendment dated November 5, 2009  
Reply to Office Action mailed on June 5, 2009  
Customer No. 27752

## REMARKS

### Claim Status

Claims 1, 2, 7, 10, 15, 16, 18, and 23 – 40 are pending in the application. Claim 1 has been amended. Support for this amendment is available in the Specification at page 10, last paragraph. Claims 27, and 35 have been amended to recite a saturated aliphatic hydrocarbon having 4 to 6 carbon atoms. New Claims 38 – 40 have also been added. Support for these claims is available in the Specification at page 10, last paragraph – page 11.

No new matter is believed to have been entered. As such, Applicants request that these claims be admitted.

### Rejection Under 35 U.S.C. § 103(a) Over Gray in view of Schmitt

Claims 1, 2, 7, 10, 15, 16, 18 and 23 – 37 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,772,203 to Gray in view of US Patent No. 3,866,800 to Schmitt. Applicants respectfully disagree.

To establish a *prima facie* obviousness of a present invention, all the claim elements must be taught or suggested by the prior art reference. *See In re Royka*, 490 F.2d 981 (C.C.P.A. 1974); MPEP § 2143.03. Furthermore, references relied upon to support a rejection under 35 U.S.C. § 103 must provide enabling disclosure, i.e., they must place the recited invention in the possession of the public. *In re Payne*, 606 F.2d 303 (C.C.P.A. 1979). Furthermore, in establishing a *prima facie* case of obviousness, case law clearly places the “burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under sections 102 and 103.” *In re Warner*, 379 F.2d 1011, 1016 (C.C.P.A. 1967).

First, Applicants respectfully submit that the cited references fail to teach or suggest the post-foaming shave gel of the present invention. Moreover, the cited

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references fail to teach or suggest the volatile self-foaming agent comprising a saturated aliphatic hydrocarbon having 4 to 6 carbon atoms as recited in Claims 1, 27, and 35.

The Office Action states: “Applicants’ remarks regarding the combination of the prior art, Gray in view of Schmitt, does not teach the post-foaming shave gel are not persuasive since the prior art, especially Schmitt, teaches **two separate components comprising a) an oxidant-containing composition and b) a reductant-containing composition is old in the art.**” [Emphasis in underline in original, emphasis in bold presently added].

Applicants respectfully submit that even if it were true that “**two separate components comprising a) an oxidant-containing composition and b) a reductant-containing composition is old in the art,**” the Office Action has failed to meet its obligations to set forth a *prima facie* case of obviousness because it has failed to show how the cited references, alone or in combination, teach or suggest each and every element of the present invention. In particular, the Office Action continues to fail to provide an explanation of where and how the cited references teach or suggest the element of the post-foaming shave gel. Moreover, the Office Action fails to demonstrate where or how the cited references teach or suggest the newly added element of the saturated aliphatic hydrocarbon.

The Supreme Court of the United States has set forth that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1739 (2007). MPEP § 2142 goes on to explain: “The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . There must be some articulated reasoning with some rational underpinning to support the legal conclusions of obviousness.”

Applicants respectfully submit that the Office Action fails to meet its obligations as set forth under KSR with respect to establishing a *prima facie* case of obviousness. In particular, Applicants point out that the cited references fail to teach or suggest the post-

foaming shave gel of the present invention. The Specification at page 4, first paragraph explains: "After dispensing, the gels provide a smooth, creamy, stable lather that develops quickly when the gels are spread over the skin. The lather remains creamy and stable when the gel is heated." The Specification goes on at page 10, last paragraph to page 11 to explain: The post-foaming agent may be any volatile hydrocarbon or halohydrocarbon with a sufficiently low boiling point that it will volatilize and foam the gel upon application to the skin, but not so low that it causes the gel to foam prematurely. . . . The post-foaming agent will be present in an amount to provide the shaving composition with a sufficiently rapid turnover – that is, transition from gel to foam when contacted with the skin – typically, in about 2 to about 30 seconds." [Emphasis added.]

With respect to Gray, Applicants respectfully submit that upon a thorough reading of Gray, Applicants can find no teaching or suggestion to arrive at a post-foaming shave gel as recited in the present claims. Gray at col. 6, lines 5 – 10 discloses cosmetic compositions which "may be in liquid, paste gel, or preferably in foam form." Nowhere does Gray teach or suggest a post-foaming gel as recited in the present claims. Further, nowhere does Gray teach or suggest the volatile saturated aliphatic hydrocarbon recited in the newly added claims. At best, Gray states and alleges that "Of course, by use of propellants, such as liquefied gases, emulsions may be dispensed as foams and liquids may be dispensed as sprays, when desired." Applicants submit that foams are not the same as post-foaming shaving gels. *See generally Ex parte Alexander Nvokov and Stephen H. Thong*, Appeal 2008 – 5149 decided March 27, 2009 by Administrative Patent Judges Adams, Grimes and McCollum (differentiating the post foaming gel of the present application with the foam of Gabby). Nowhere does Gray teach or suggest a post-foaming shaving gel.

Turning to Schmitt, Applicants submit that Schmitt fails to correct the outages of Gray because Schmitt also fails to teach or suggest the post-foaming shaving gel of Claim 1. The cosmetic composition of Schmitt is disclosed as a composition, "particularly cosmetic products which are intended for application to the skin and hair and where enhancement of the utility of said products results from heat and evolution of a gas or, in

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certain instances, the production of a foam.” *See* Schmitt at col. 1, lines 10 – 15. Schmitt does nothing to teach or suggest modifying the foam of Gray to arrive at the post-foaming shave gel of the present invention. As such, Applicants submit that the cited references, alone or in combination fail to teach or suggest each and every element of the present invention.

Applicants respectfully submit that the Office Action has failed to meet its obligations under *KSR* to demonstrate a *prima facie* case of obviousness. As such, Applicant submit that Gray fails to teach or suggest each and every element of the present invention.

With regard to all claims not specifically mentioned, these are believed to be allowable not only in view of their dependency on their respective base claims and any intervening claims, but also for the totality of features recited therein.

All claims are believed to be in condition for allowance. Should the Examiner disagree, Applicants respectfully invite the Examiner to contact the undersigned agent for Applicants to arrange for a telephonic interview in an effort to expedite the prosecution of this matter.

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### CONCLUSION

In light of the above remarks, it is requested that the Examiner reconsider and withdraw the above mentioned rejections. Early and favorable action in the case is respectfully requested. Should any additional fees be required, please charge such fee to Procter & Gamble Deposit Account No. 16-2480.

Respectfully submitted,

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